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BMW OF NORTH AMERICA, LLC
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BAYERISCHE MOTOREN WERKE AG

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Attorneys for Defendants
VALERY MIFTAKHOV and
EMOTORWERKS, LLC

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

BMW OF NORTH AMERICA, LLC and
BAYERISCHE MOTOREN WERKE AG,

Plaintiffs,

v.

VALERY MIFTAKHOV, d/b/a ELECTRIC
MOTOR WERKS, and EMOTORWERKS,
LLC,

Defendants.

Case No. 3:13-cv-04058-WHA

**CONSENT JUDGMENT AND
PERMANENT INJUNCTION**

Judge: Hon. William Alsup

Plaintiffs BMW of North America, LLC and Bayerische Motoren Werke AG (collectively, “Plaintiffs” or “BMW”), having filed a Complaint on August 30, 2013 and an Amended Complaint on October 2, 2013 against Defendants Valery Miftakhov, d/b/a Electric Motor Werks, and Emotorwerks, LLC (collectively, “Defendants”) claiming trademark infringement under 15

1 U.S.C. § 1114(1), unfair competition and false designation of origin under 15 U.S.C. § 1125(a),
2 trademark dilution under 15 U.S.C. § 1125(c), unfair competition under Cal. Bus. & Prof. Code
3 §§ 17200 *et seq.*, trademark dilution under Cal. Bus. & Prof. Code § 1427(a), and trademark
4 infringement and unfair competition under California common law;

5 Plaintiffs, having alleged that they have, in connection with their business of, *inter alia*,
6 designing, manufacturing, distributing, servicing, and selling automobiles and providing parts and
7 accessories for automobiles, extensively used and advertised said products and services under
8 their “BMW” mark, Roundel logo, THE ULTIMATE DRIVING MACHINE mark, and THE
9 ULTIMATE DRIVING EXPERIENCE mark, and that Plaintiffs are the exclusive owners of valid
10 and subsisting federal trademark registrations, including incontestable trademark registrations, for
11 these marks, and that these marks are well-known and/or famous and distinctive marks among
12 purchasers of motor vehicles as well as among members of the general public, and Defendants
13 having acknowledged same;

14 Defendants, having offered electric car conversions under the mark “EMW,” a modified
15 Roundel logo, the phrase “Drive No Evil/Make Your Car Electric” with a depiction of a BMW
16 vehicle, the advertising slogan “BMW - Now Electric”, and the slogan “THE GREEN
17 ULTIMATE GREEN DRIVING EXPERIENCE”;

18 Defendants, without admitting any of the allegations of the Amended Complaint and
19 without admitting any liability, and expressly denying same, solely to avoid the expense and
20 distraction of protracted litigation, and wishing to settle their dispute with Plaintiffs amicably;

21 Defendants, acknowledging the jurisdiction of this Court over them and the subject matter
22 hereof; having waived the entry of findings of fact and conclusions of law pursuant to Rule 52 of
23 the Federal Rules of Civil Procedure; and having waived any objections with regard to the right to
24 appeal this Consent Judgment;

25 It further appearing that this Court has jurisdiction over the subject matter hereof;

26 With the consent of Plaintiffs and Defendants, and for good cause, **IT IS HEREBY**
27 **ORDERED, ADJUDGED AND DECREED** that:
28

1 1. Defendants, their subsidiaries, affiliates, directors, officers, agents, servants,
2 employees, representatives, successors, assigns, attorneys-in-fact, and all those persons in active
3 concert or participation with them who receive actual notice of this Consent Judgment by
4 personal service or otherwise, and each of them, be and hereby are enjoined and restrained from:

5 A. Using the trade name or trademark “EMW”, either alone or with other
6 letters, shapes, or words, in connection with Defendants’ trade name or business,

7 B. Using the modified Roundel logo depicted below in connection with
8 Defendants’ business;



15 C. Using “THE GREEN ULTIMATE DRIVING EXPERIENCE” slogan and
16 any other colorable imitations of BMW’s THE ULTIMATE DRIVING MACHINE and THE
17 ULTIMATE DRIVING EXPERIENCE marks in connection with Defendants’ business;

18 D. Using the advertising slogan “BMW - Now Electric”;

19 E. Depicting a BMW vehicle in connection with the advertising slogan “Drive
20 No Evil/Make Your Car Electric”;

21 F. Making any trademark use of any other BMW trademarks or logos, or
22 colorable imitations thereof;

23 G. Indicating or suggesting in any manner that Defendants’ goods or services
24 are or were somehow sponsored, or approved by or affiliated with BMW;

25 H. Passing off, promoting, or selling any product or service as a product or
26 service authorized by or under the supervision or control of BMW when such, in fact, is not the
27 case;

1 I. Indicating in any matter that Plaintiffs' trademarks, logos or trade dress
2 belong to or are owned by Defendants; and

3 J. Doing any other act or thing likely to confuse, mislead, or deceive others
4 into believing that Defendants, or their products or services, emanate from, or are connected with,
5 sponsored by, or approved by BMW.

6 **IT IS FURTHER ORDERED, ADJUDGED AND DECREED** that Defendants are
7 directed to:

8 2. Remove the "EMW" mark, the modified Roundel logo depicted above, "THE
9 GREEN ULTIMATE DRIVING EXPERIENCE" and "BMW - Now Electric" slogans, and
10 images of BMW vehicles in connection with the slogans "Drive No Evil/Make Your Car Electric"
11 from signs, flags, banners, conversion products, interior and exterior walls, window etchings,
12 websites, commercial videos, clothing and accessories, photographs, telephone directory or other
13 internet or print advertisements, promotional activities, stationery, business cards, and anywhere
14 else in connection with Defendants' business;

15 3. In accordance with Section 36 of the Lanham Act, 15 U.S.C. § 1118, destroy all
16 business cards, labels, signs, photographs, prints, packages, bottles, receptacles, containers,
17 papers, shirts, hats, advertisements and other promotional materials in Defendants' possession or
18 control bearing any use of BMW's Roundel logo, THE ULTIMATE DRIVING MACHINE mark,
19 THE ULTIMATE DRIVING EXPERIENCE mark and trademark use of the "BMW" mark, or
20 colorable imitations thereof; and

21 4. File with the Court and serve on counsel for Plaintiffs within sixty (60) days after
22 entry of this Order, a sworn written statement pursuant to § 34(a) of the Federal Trademark Act,
23 15 U.S.C. § 1116(a), setting forth in detail the manner and form in which the Defendants have
24 complied with this Consent Judgment.

1 **IT IS FURTHER HEREBY ORDERED, ADJUDGED AND DECREED** that:

2 5. ~~This Court shall retain jurisdiction of this matter for the purpose of enforcing the~~
3 ~~terms of this Consent Judgment.~~ The parties acknowledge that a breach of this Consent Judgment
4 by Defendants or their agents would result in immediate and irreparable injury to BMW, that it
5 would be difficult or impossible to establish the full monetary value of such damage, and that
6 BMW would be entitled to immediate injunctive relief to enforce this Consent Judgment and to
7 reimbursement of its reasonable attorney's fees and costs arising from enforcement of such a
8 breach;

9 6. BMW and Defendants shall each bear their own attorneys' fees and expenses
10 incurred in connection with the Amended Complaint and Consent Judgment.

11 7. Defendants shall provide a copy of this Consent Judgment to each of their
12 affiliates, partners, managers, agents, representatives, successors, and assigns.

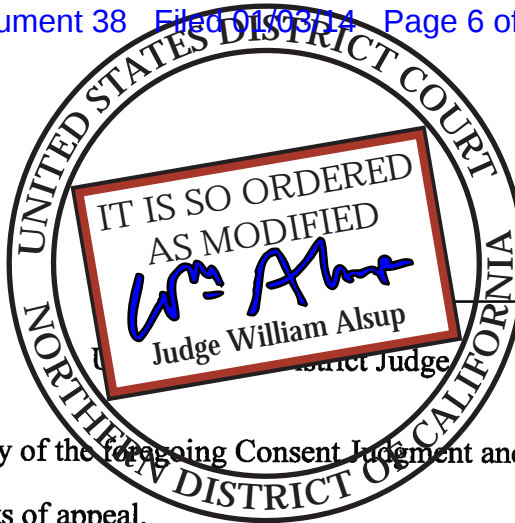
13 8. This Consent Judgment is binding upon Defendants and their officers, agents,
14 servants, employees, independent contractors and attorneys, or any other person or entity acting
15 in concert or participating with the Defendants.

16 9. This Court shall retain jurisdiction of this matter and over the parties thereto for
17 the purpose of enforcing the terms of this Consent Judgment and the separate Settlement
18 Agreement entered into between Plaintiffs and the Defendants with respect to the subject matter
19 of this action for no more than 120 days.

20 10. In accordance with § 34 of the Federal Trademark Act, 15 U.S.C. § 1116, the
21 Clerk of the Court shall notify the Commissioner of Patents and Trademarks of the entry of this
22 Final Judgment who shall enter it upon the records of the United States Patent and Trademark
23 Office.

24 11. There being no just reason for delay, the Clerk of this Court is hereby directed,
25 pursuant to Rule 54(b) of the Federal Rules of Civil Procedure, to enter this Consent Judgment
26 forthwith.

27 **IT IS SO ORDERED.**
28



1 Dated: January 3, 2014.

2
3
4
5 The parties hereby consent to the entry of the foregoing Consent Judgment and Permanent
6 Injunction and waive any and all rights of appeal.
7

8 BMW of North America, LLC

9 By: [Signature]

10 Dated: 12-31-13

Bayerische Motoren Werke AG

By: [Signature]

Dated: 12-31-13

11
12 Valery Miftakhov

13 By: _____

14 Dated: _____

Electric Motor Werks

By: _____

Dated: _____

15
16 Emotorwerks, LLC

17 By: _____

18 Dated: _____

The parties hereby consent to the entry of the foregoing Consent Judgment and Permanent Injunction and waive any and all rights of appeal.

BMW of North America, LLC

Bayerische Motoren Werke AG

By: _____

By: _____

Dated: _____

Dated: _____

Valery Miftakhov

Electric Motor Werks

By: _____

By: _____

Dated: 12/30/2013

Dated: 12/30/2013

Emotorwerks, LLC

By: _____

Dated: 12/30/2013